

Appl. Ser. No.10/729,142
Response dated May 26, 2005
Reply to Office Action mailed May 6, 2005

Atty. Docket No. CWD-026746-US-P1

REMARKS

Claims 1-47 are pending in the application. Claims 1-43 have been allowed. Independent claim 44 stands rejected under 35 U.S.C §102(e) as being anticipated by U.S. Patent No. 6,878,878 to Westlake ("*Westlake*"). Claim 44 also stands rejected under 35 U.S.C §103(a) as being obvious over U.S. Patent No. 1,400,824 to Knoderer ("*Knoderer*") in view of *Westlake*. Claims 45-47 are objected to as being dependent upon a rejected base claim. Applicants respectfully request reconsideration of these rejections.

ANTICIPATION REJECTION

The Examiner's rejection of claim 44 as being anticipated by *Westlake* must be withdrawn. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). *See also*, MPEP § 2131. The cited *Westlake* patent clearly does not disclose all of the elements recited in claim 44.

Claim 44 is directed to a "cover plate", which covers electrical fixtures, such as receptacles and switches, and provides access to the electrical fixtures through the cover plate. (Specification at page 16, line 16-19). In contrast, *Westlake* discloses an extension cover 10 for junction boxes 100 that house electrical wires at certain junctions throughout an electrical system. (*Westlake*, col. 1, lines 14-54; FIGS. 1-6.) More specifically, the disclosed cover acts both as a complete cover for the junction box (i.e., preventing access through the cover to the junction box) (*Westlake*, col. 2, lines 37-40) and an extension for the junction box (in the form of

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a raised surface), which provides more space inside the junction box for excess wiring (*Westlake*, col. 2, lines 11-24; col. 5, lines 12-16).

Claim 44 also recites a specific shape and configuration for the cover plate, which provides advantages in installing and removing the cover plate inside the base of a weather proof electrical enclosure. See, e.g., cover plate 140 in FIG. 1. The extension cover disclosed by *Westlake* does not include any of these features, as it is used for a completely different purpose and positioned on top of the junction box.

Claim 44 recites a cover plate comprising a generally planar surface. In contrast, *Westlake* discloses a cover 10 having a rim portion 12, a transition portion sloping inwards and upwards from the rim portion and an elevated portion 16 lying in a different plane than the rim portion. (*Westlake*, col. 3, lines 25-45; col. 4, lines 50-55; and FIG. 6.) The transition portion and elevated portion act as an extension for the junction box so that the junction box can hold excess wiring (*Westlake*, col. 2, lines 11-49) and also allows multiple junction box extension covers to be stacked on top of each other (*Westlake*, col. 2, lines 44-48).

Applicants' cover plate as recited in claim 44 also comprises first and second "arcuate cut-out sections" respectively disposed at diagonally opposite top and bottom corners of the cover plate. The arcuate cut-out sections provide space between the cover plate and the walls of the enclosure, thereby allowing a user to place his fingers therein for easy installation, positioning and removal of the cover plate from within the enclosure. (See, specification at page 3, line 14-18 and page 20, line 6-8) No such cutouts are disclosed in *Westlake* as they are not needed for the intended use of the *Westlake* cover. The *Westlake* cover has "straight" edges at every corner (see, *Westlake* at FIG. 6), the purpose of which is to allow the junction box

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extension cover to be mounted on top of an octagonal-shaped junction box. (See, *Westlake*, col. 4, lines 42-45). ("In a third embodiment shown in FIG. 5 [*This actually refers to FIG. 6. See, Westlake, col. 3, lines 1-2*], the plate element 11 and the junction box 100 both have an octagonal shape.")

Finally, *Westlake* does not disclose horizontally elongated mounting holes that are horizontally disposed on the substrate as recited in claim 44. Instead, *Westlake* discloses two slots 18, 20 that are diagonally disposed on the extension cover 10. More specifically, slot 18 is diagonally disposed on the extension cover 10 parallel to the first edge 13 of the extension cover and slot 20 is diagonally disposed on the extension cover at an angle traverse to the angular orientation of slot 18 (*Westlake*, col. 4, lines 39-51; FIG. 6.)

OBVIOUSNESS REJECTION

The Examiner's rejection of claim 44 as being obvious over *Knoderer* in view of *Westlake* must also be withdrawn. "To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." MPEP § 2143. Here, the references cited by the Examiner, taken alone or in combination, do not disclose, teach or suggest a cover plate as defined in claim 44.

Knoderer does not teach or suggest a cover plate suitable for use with a weatherproof electrical enclosure as recited in claim 44. Instead, *Knoderer* discloses a cover 1 for an outlet box 3. (*Knoderer*, col. 1, lines 31-33; FIG. 1.) Unlike Applicants' cover plate, which provides

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Atty. Docket No. CWD-026746-US-P1

access to electrical fixtures such as switches and outlets, the cover of *Knoderer* provides a "mounting" for electrical fixtures (e.g. a lamp socket) via a fixture securing ring member 6 arranged concentrically with an opening 5 in the cover 1. (*Knoderer*, col. 1, lines 31-50; FIG. 1.) The fixture securing ring member 6 extends upward from the surface of cover, as opposed to the claimed generally planar surface. Further, as explained above, the cover plate of claim 44 is positioned inside the base of the enclosure. In contrast, the cover of *Knoderer* is positioned on top of an outlet box 3. See, *Knoderer* at FIG. 1.

Knoderer also does not disclose, teach or suggest horizontally elongated mounting holes that are horizontally disposed on the substrate as recited in claim 44. Instead, *Knoderer* discloses circular openings 4. (*Knoderer*, col. 1, lines 35-36; FIG. 1.) Because of the circular shape of these openings 4, they cannot reasonably be described as horizontally disposed on the cover as the Examiner states.

It is well-settled that the mere fact that the prior art could be modified to form the invention would not make that modification obvious unless the prior art suggested the desirability of the modification. *In re Laskowski*, 10 U.S.P.Q. 2d 1397, 1398 (Fed. Cir. 1989); *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed Cir. 1984). Here, *Knoderer* does not disclose, teach or suggest the desirability of modifying its cover for use as a cover plate configured with a generally planar surface or horizontally elongated mounting holes horizontally disposed on the substrate for easy installation, positioning and removal from within an electrical enclosure.

Westlake does not overcome the deficiencies of the *Knoderer* patent. *Westlake* is cited only for disclosing use of an elongated mounting hole 18 to allow for slight variation in

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alignment of slots with junction box screw holes. The Examiner asserts it would have been obvious to replace the round mounting hole of *Knoderer* with the elongated mounting hole of *Westlake* to allow for slight variation in alignment of the mounting holes with a junction box's screw holes. However, *Westlake* does not teach or suggest the desirability of modifying its cover for use as a cover plate configured with arcuate cutouts and horizontally elongated mounting holes for easy installation, positioning and removal from within an electrical enclosure.

Most fundamentally, the Examiner's proposed combination does not yield the invention recited in claim 44. In particular, the proposed combination does not yield a cover plate suitable for use in a weatherproof electrical enclosure or horizontally elongated mounting holes that are horizontally disposed on a generally planar substrate having arcuate cut-out sections at diagonally opposed corners to facilitate installation, positioning and removal of the cover plate in an electrical enclosure, as recited in claim 44.

The Examiner's assertion that the preamble recitation of a weatherproof enclosure should not be considered is without basis. All factual differences in any portion of a claim must be included within the basis for comparison with the prior art. *In re Duva*, 156 U.S.P.Q. 90, 94 (C.C.P.A. 1967) ("The command of 35 U.S.C. 103 is to compare the invention *as a whole* with the prior art.... [W]e think every portion of the appealed claims must be considered in determining the invention as a whole in arriving at our decision as to obviousness required by a rejection under section 103.")

Finally, the Examiner asserts that *Westlake* discloses that weatherproof electrical enclosures are obvious. However, claim 44 is directed to a cover plate configured for use in an

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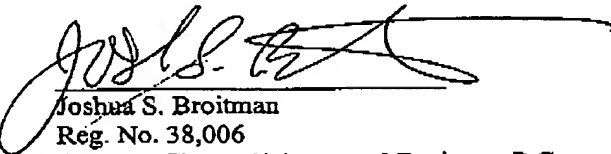
Atty. Docket No. CWD-026746-US-P1

electrical enclosure. As set forth above, neither *Westlake* nor *Knoderer* disclose, teach or suggest such a cover plate.

Accordingly, Applicants submit that independent claim 44, and claims 45-47, depending therefrom, are not obvious in view of the cited patents, and the rejection under 35 U.S.C. §103 must be withdrawn. In view of the foregoing, Applicants believe that all pending claims are allowable and request that this case be passed to issue. However, if any issue remains to be resolved, Applicants request that the Examiner telephone the undersigned.

Respectfully submitted,

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